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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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NUTTER,N EXAMINER

15M1/0622

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ART UNIT	PAPER NUMBER
1503	11

DATE MAILED: 06/22/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 8 March 1993 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire ~~month~~(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1 - 25 are pending in the application.
   Of the above, claims 1-5 and 16-20 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims _____ are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 6 - 15 and 21-25 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Applicant's election with traverse of group II in Paper No. 9 is acknowledged. The traversal is on the ground(s) that "(n)o one claim does not contain a drug", and "use of applicants' invention in a cosmetic would still not change its character for the treatment of disease and/or conditions". This is not found persuasive because the group I claims are drawn to a composition and the group II claims are drawn to a method of use of the composition. It is pointed out to applicants that the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h). This has been shown by the examiner with relation to US Patent No. 4,851,521 to della Valle et al. as pointed out in the restriction requirement. These products can be used in different capacities. As evidenced by the della Valle et al. patent, further, the process may be practiced by using another materially different product. Both distinctions have been made. Further, the two inventions are classified in different art areas.

The requirement is still deemed proper and is therefore made FINAL.

The following restriction is further placed into effect:

This application contains claims directed to the following patentably distinct species of the claimed invention: treatment of different diseases or conditions of:

1) basal cell carcinoma,

2) actinic keratoses (sic) lesions,

3) fungal lesions

4) "'liver' spots and like (sic) lesions",

5) squamous cell tumors,

6) metastatic cancer of the breast to the skin,

7) primary and metastatic melanoma in the skin,

8) genital warts (condyloma acuminata),

9) cervical cancer,

10) HPV (Human Papilloma Virus),

11) psoriasis,

12) corns, and

13) "hair loss on the head of pregnant women"

These disease states are each different in scope and require different treatments. A patent to one disease or malady claimed would not necessarily be drawn to each and or every other disease or condition claimed as to be applied against the claims of the instant applicant.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which

the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 6-15 and 21-25 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Due to the complexity of the requirement a telephonic election of the claims was not attempted by the examiner.

Any inquiry concerning this communication should be directed to Nathan M. Nutter at telephone number (703) 308-2351.

Nathan M. Nutter:cb
June 18, 1993
June 22, 1993

NATHAN M. NUTTER
PATENT EXAMINER
ART UNIT 153